

Remarks

1. Summary of Office Action

In the office action mailed December 2, 2004, the Examiner rejected claims 3-9, 11-13, 16-21, 23, 25-26, 36, and 38-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,643,517 (Steer). Further, the Examiner rejected claims 28-29, 33, and 37 under 35 U.S.C. § 103(a) as being obvious over a combination of Steer and U.S. Patent No. 5,778,304 (Grube).

2. Amendments and Pending Claims

Applicant has amended claims 11 and 23, and has cancelled claims 12-13, 18-19, 25-26, 28-29, and 36-39. Now pending in this application are claims 3-9, 11, 16-17, 20-21, 23, and 33, of which claims 11 and 23 are independent, and the remainder are dependent.

3. Response to § 102 Rejections

As noted above, the Examiner rejected claims 3-9, 11-13, 16-21, 23, 25-26, 36, and 38-39 under 35 U.S.C. § 102(e) as being anticipated by Steer. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant respectfully traverses the anticipation rejection of pending claims 3-9, 11, 16-17, 20-21, and 23 because Steer does not disclose or suggest each and every element as recited in any of these claims as amended.

Applicant has amended independent claims 11 and 23 to include a function in which upon a predetermined duration after the device has exited the given location, the device reverts to a previous state of the device. The Examiner has already examined this function with respect to claim 13. Steer does not teach this function.

In particular, Steer fails to teach a method that involves upon a predetermined duration after the device has exited the given location, reverting to carrying out the first functional

response to the first primitive rather than the new functional response to the first primitive, as recited in claim 11.

Similarly, Steer fails to teach a method that involves upon a predetermined duration after the device has exited the given location, reverting to employing the first predetermined primitive in carrying out the first function, rather than employing the new primitive in carrying out the first function, as recited in claim 23.

At best, Steer teaches a method in which a device operates in a restricted mode upon determination that the device is inside a protected region, and operates in an unrestricted mode upon determination that the device is outside the protected region. (*See, e.g.*, Steer, at 3, lines 50-60; column 7, lines 34-47; Figure 3). However, Steer does not teach a method in which upon a predetermined duration after the device has exited the given location, the device reverts to a previous state of the device.

Because Steer does not teach each and every element of claims 11 and 23, Steer fails to anticipate claims 11 and 23 under 35 U.S.C. § 102(e). Further, because each of claims 3-9, 16-17, and 20-21 depend from either claim 11 or claim 23, Steer necessarily also fails to anticipate claims 3-9, 16-17, and 20-21 as well. Applicant traverses the rejection of claims 12, 18-19, 25-26, 28-29, 36 and 38-39 as moot, as these claims have been cancelled.

4. Response to § 103 Rejections

The Examiner next rejected claims 28-29, 33, and 37 under 35 U.S.C. § 103(a) as being obvious over a combination of Steer and Grube. According to M.P.E.P § 2143, in order to establish a *prima facie* case of obviousness of a claimed invention by applying a combination of references, the combination must disclose or suggest all of the claim limitations. Applicant respectfully traverses the obviousness rejection of claim 33 because the combination of Steer and

Grube fails to disclose or suggest all of the limitations of this claim, as required to support an obviousness rejection.

Claim 33 depends from claim 11 and thus incorporates all of the limitations of claim 11. The combination of Steer and Grube fails to disclose or suggest a method in which upon a predetermined duration after the device has exited the given location, reverting to carrying out the first functional response to the first primitive rather than the new functional response to the first primitive.

At best, the combination of Steer and Grube teaches a method in which (i) a message is sent to a device when a determination is made that the device is located within a predetermined geographical region, and (ii) the device determines whether an action is required, and if so performs the action automatically or manually. (*See, e.g., Grube, at 3, lines 30-52, Figure 2*). However, Applicant does not see in the combination of Steer and Grube any teaching that involves upon a predetermined duration after the device has exited the given location, reverting to carrying out the first functional response to the first primitive rather than the new functional response to the first primitive.

Because the combination of Steer and Grube fails to disclose or suggest all of the limitations of claim 33, a prima facie case of obviousness of this claim does not exist. Applicant traverses the rejection of claims 28-29 and 37 as moot, as these claims have been cancelled.

5. Conclusion

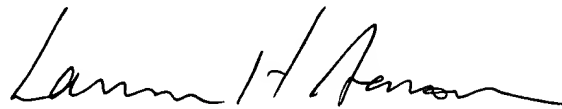
For the foregoing reasons, Applicant submits that claims 3-9, 11, 16-17, 20-21, 23, and 33 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

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By:



Lawrence H. Aaronson
Reg. No. 35,818